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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,795	07/11/2001	Stanley C. Johnson	7060-3	1478

7590 01/27/2004

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

12

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,795

Applicant(s)

JOHNSON, STANLEY C.

Examiner

Jane J Rhee

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-43 is/are pending in the application.
- 4a) Of the above claim(s) 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/7/03 has been entered.

Withdrawn Rejections

2. The 35 U.S.C. 103 rejection of claims 24-34 over Talbot et al. in view of Hoffman of record in paragraph 2 of Paper 7 has been withdrawn due to applicant's amendment and arguments in Paper 11.

New Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24-35, 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talbot et al. in view of Robbins (4844763) in further view of Hoffman (5071688).

Art Unit: 1772

Talbot et al. discloses a wood product comprising an elongate composite substrate (figure 1 number 20), a core defining the interior of the substrate (figure 1 number 24), an elongate front surface formed on one side of the substrate (figure 1 number 35), an elongate rear surface formed on the other side of the substrate (figure 1 number 37) a pair of opposing edge surfaces extending between the front and rear surfaces (figure 1 number 27), the core being exposed on the edge surfaces (figure 1 number 24), veneer substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces (figure 1 number 27,31, and 35), the covered portion being substantially all of the trim that is visible when the trim is installed in on the building (figure 1 numbers 35,27,31). Talbot et al. discloses an adhesive spread between substantially all of the veneer and the substrate (col. 1 lines 40-44). Talbot et al. discloses that the trim is fixedly mounted on the building (col. 1 lines 13-14). Talbot et al. discloses that the rear surface includes a mounting surface that flushly abuts the building when the trim is mounted thereon (figure 1 number 37). Talbot et al. discloses that the substrate comprises an engineered wood product (col. 4 lines 3-4). Talbot et al. discloses that the substrate has a substantially rectangular cross section (figure 1 number 24). Talbot discloses that the veneer covers a portion of the rear surface adjacent both of the edge surfaces (figure 1 numbers 35,27). Talbot et al. discloses engineered wood product that comprises fiberboard and wherein the front surface comprises a top surface of the fiberboard and the edge surface comprises an edge of he fiberboard (col. 4 line 4).

Talbot et al. discloses that at least one edge surface is substantially planar (figure 1 number 26).

Talbot et al. fail to disclose a treated paper covering the surfaces of the trim product.

Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19) for the purpose of providing improved dimensional stability of laminated veneer lumber that can be made on conventional apparatus as a commercially acceptable production rate (col. 2 lines 65- col. 3 lines 1-2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Talbot et al. with a treated paper covering in order to provide improved dimensional stability of laminated veneer lumber that can be made on conventional apparatus as a commercially acceptable production rate (col. 2 lines 65- col. 3 lines 1-2) as taught by Robbins.

Talbot et al. and Robbins fail to disclose a resin treatment formed on at least the exposed surface of the paper. Talbot et al. and Robbins fail to disclose that the engineered wood product comprises laminated veneer lumber wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber. Talbot et al. and Robbins fail to disclose that the laminated veneer lumber comprises plywood.

Hoffman teaches a resin treatment formed on at least the exposed surface of the veneer (col. 2 lines 7-9) for the purpose of obtaining a planar smooth surface (col. 2

Art Unit: 1772

lines 10-11). Hoffman teaches that the engineered wood product comprises laminated veneer lumber, plywood wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber (figure 5 col.2 lines 27-29) for the purpose of cost saving (col. 1 line 33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Talbot et al. with a resin treatment formed on at least the exposed surface of the paper in order to obtain a planar smooth surface (col. 2 lines 10-11) as taught by Hoffman.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Talbot et al. with the engineered wood product that comprises laminated veneer lumber, plywood wherein the front surface comprises a surface on an outer veneer of the substrate and the edge surfaces comprises edges of veneer layers in the laminate veneer lumber in order to be cost saving (col. 1 line 33) as taught by Hoffman.

As for the wood product comprising siding or fascia, using the wood product as siding or fascia is an intended use and it has been held that a recitation with respect to the manner in which the claimed article is intended to be employed does not differentiate the claimed article from a prior art claimed article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Art Unit: 1772

4. Claims 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talbot et al. and Robbins (4844763) and Hoffman (5071688) in view of Nichols (5569505).

Talbot et al., Robbins, and Hoffman discloses the wood product described above. Talbot et al., Robbins, and Hoffman fail to disclose that at least one edge surface is substantially nonplanar. Nichols teaches that at least one edge surface is substantially nonplanar (figure 1 number 24) for the purpose of providing an aesthetically pleasing panel edge appearance (col. 3 lines 41-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Talbot et al. with at least one edge surface that is substantially nonplanar in order to provide an aesthetically pleasing panel edge as taught by Nichols (col. 3 lines 41-42).

Response to Arguments

5. Applicant's arguments with respect to claims 24-34 have been considered but are moot in view of the new ground(s) of rejection.

Response to Declaration

6. The Johnson declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of

Art Unit: 1772

ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

The Caylor declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

The Sangret declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Art Unit: 1772

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and ~~703-872-9311 for After Final communications.~~

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
January 12, 2004


NASSER AHMAD
PRIMARY EXAMINER